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09/591,714	06/12/2000	Gary L. Cole	END9-1997-0019-US2	3696

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EXAMINER

NGUYEN BA, HOANG VU A

ART UNIT

PAPER NUMBER

2122

5

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/591,714

Applicant(s)

COLE, GARY L.

Examiner

Hoang-Vu A Nguyen-Ba

Art Unit

2122

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 June 2000.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-15 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 12 June 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This action is responsive to the application filed June 12, 2000, which is a continuation-in-part claiming the benefit of U.S. Patent Application No. 08/814,771, filed March 7, 1997 and issued as U.S. Patent No. 6,074,434, which is itself a continuation-in-part of U.S. Patent Application No. 08/659,841, filed on June 7, 1996 and issued as U.S. Patent No. 5,752,042.
2. Claims 1-15 have been examined.

### *Specification*

3. The Abstract is objected to because it contains more than 150 words.  
Correction is required.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. § 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claim 7 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites the limitation "The system according to claim 6" at line 1. There is insufficient antecedent basis for this limitation in the claim. The limitation "The system according to claim 6" should be changed to – The administration server according to claim 6 – in order to have proper antecedent basis.

### *Double Patenting*

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Long*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1993); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Voge*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminated disclaimer in compliance with 37 CFR 1.103(c) 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1, 4, 9, 12 and 15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 7, 10, 16, 22, 23, 24, 28 and 29 of U.S. Patent No. 5,752,042 to Cole et al. al.. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons.

The following features recited in the instant claims appear to be obvious variations of the following ones recited in the patent claims:

Instant Claim	Patent Claim
configuration receiving means for	means for receiving results of said

receiving and storing a set of system configuration attributes from the processor group, the system configuration attributes indicating whether a copy of a client software program may be applicable to the processor group	programs, generating a list of code updates which are consistent with said basic system characteristics, represent current version of code within said client computer and are not currently resident in said client computer, and transmitting said list or information about said list to said client computer
update recognizer transmitting means for transmitting the update recognizer program to the processor group, wherein the processor group executes the update recognizer program to issue a notification indicating whether a software program update is applicable to the copy of the client software program in the processor group	means for sending to said client computer one or more programs which execute in said client computer to determine whether said client computer has a version other than a current version of the identified code updates

The additional feature "selection server" as recited in the instant claims is not specifically recited in the patent claims. However, this additional feature is inherently part of the server disclosed in 5,752,042. See Figure 2, block 12.

It is noted that since:

- 1) the subject matter recited in the claim of the instant application is fully disclosed in the patent and covered by the independent claim in the patent; and

2) There is no reason why applicant was prevented from presenting the same claims for examination in the issued patent

a non-statutory double-patenting rejection is appropriate.

Since claims 2-3, 5-8, 10-11 and 13-14 depend from claims 1, 4, 9 and 12, respectively, these claims are also rejected for the same reasons.

### *Claim Rejections – 35 U.S.C. § 102*

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent,

except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

9. Claims 1-15 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,619,716 to Nonaka et al. (“Nonaka”).

### **Claims 1, 4, 9, 12 and 15**

Nonaka discloses at least:

*configuration receiving means for receiving and storing a set of system configuration attributes from the processor group, the system configuration attributes indicating whether a copy of a client software program may be applicable to the processor group (see at least Figure 1, blocks 10, 16, 18 and related discussion in the specification);*

*configuration transmitting means for transmitting (see at least Figure 1, blocks 10, 16, 18 and related discussion in the specification) the set of system configuration attributes to a selection server (see at least Figure 1, block 15 and related discussion in the specification);*

*update receiving means for receiving an update recognizer program from the selection server, the update recognizer program being associated with the client software program (see at least Figure 1, blocks 10, 16, 18 and related discussion in the specification); and*

*update recognizer transmitting means for transmitting the update recognizer program to the processor group, wherein the processor group executes the update recognizer program to issue a notification indicating whether a software program update is applicable to the copy of the client software program in the processor group (see at least Figure 1, blocks 10, 20, 25, 26, 27 and related discussion in the specification).*

### **Claims 2, 5, 10 and 13**

Nonaka further discloses:

*notification receiving means for receiving the notification from the processor group (see at least Figure 1, blocks 10, 18 and related discussion in the specification); and*

*update transmitting means responsive to the notification for transmitting the software program update to the processor group if the software program update is applicable to the copy of the client software program in the processor group (see at least Figure 1, blocks 10, 16, 18 and related discussion in the specification).*

### **Claims 3, 8 and 14**

Nonaka further discloses *system recognizer transmitting means for transmitting a system recognizer program to the processor group, wherein the processor group executes the system recognizer*

*program to determine the system configuration attributes*(see at least Figure 1, blocks 10, 16, 18, 20 and related discussion in the specification).

#### **Claim 6**

The rejection of base claim 4 and intervening claim 5 is incorporated. Nonaka further discloses *selecting means for selecting at least one of the plurality of software programs and at least one of the plurality of client processors of the processor group, the update transmitting means being responsive to the selecting means for transmitting a software program update associated with each selected software program to each selected client processor*(see at least Figure 1, blocks 10, 16, 18 and related discussion in the specification).

#### **Claim 7**

The rejection of base claim 4 and intervening claims 5-6 is incorporated. Nonaka further discloses *wherein the selecting means utilizes an additional user-defined criterion other than a hardware configuration or software configuration of the plurality of client processors to perform the selecting* (see at least Figure 1, block 18 and related discussion in the specification).

#### **Conclusion**

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Antony Nguyen-Ba, whose telephone number is (703) 305-0103. The examiner can normally be reached on Tuesday - Friday from 6:15 – 3:45 p.m.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam, can be reached at (703) 305-4552.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Central Fax Number

(703) 872-9306

A handwritten signature in black ink, reading "Hoangin Antony Nguyen Ba". The signature is written in a cursive, flowing style.

**ANTONY NGUYEN-BA**  
**PRIMARY EXAMINER**

Art Unit 2122

March 23, 2004